

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: Alesandro Massimo GIANNI

Appln. No. 09/869,612

Date Filed: November 13, 2001

For: HUMAN GROWTH HORMONE TO STIMULATE MOBILIZATION

Art Unit: 1647

Examiner: Fozia M. HAMUD

Washington, D.C.

Atty.'s Docket: GIANNI=1

Date: July 2, 2003

Confirmation No. 5788

Mail Stop - NON-FEE AMENDMENT

THE COMMISSIONER OF PATENTS AND TRADEMARKS

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:



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JUL 03 2003
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Transmitted herewith is a ☒ REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

☐ Small entity status of this application under 37 CFR 1.9 and 1.27 has been established by a verified statement previously submitted

☐ Applicant claims small entity status. See 37 C.F.R. §1.27.

☒ No fee is required.

The fee has been calculated as shown below:

(Col. 1)		(Col. 2)		(Col. 3)	SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS	RATE	ADDITIONAL FEE		RATE	ADDITIONAL FEE
TOTAL	*	MINUS	** 20		x 9	\$		x 18	\$
INDEP.	*	MINUS	*** 3		x 42	\$		x 84	\$
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM					+ 140	\$		+ 280	\$
					ADDITIONAL FEE TOTAL	\$	OR	TOTAL	\$

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

☐ First - \$ 55.00
☐ Second - \$ 205.00
☐ Third - \$ 465.00
☐ Fourth - \$ 725.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

☐ First - \$ 110.00
☐ Second - \$ 410.00
☐ Third - \$ 930.00
☐ Fourth - \$ 1450.00

Month After Time Period Set

☐ Less fees (\$) already paid for month(s) extension of time on .

☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK

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ATTY.'S DOCKET: GIANNI=1

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Appln. No.: 09/869,612)	Washington, D.C.
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Date Filed: November 13, 2001)	Confirmation No.: 5788
)	
For: HUMAN GROWTH HORMONE TO)	July 2, 2003
STIMULATE MOBILIZATION)	

#8
#9
7/21/03

REPLY TO RESTRICTION REQUIREMENT

Mail Stop - _____
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Replying to the Restriction Requirement mailed June 2, 2003, and in view of the requirement for Applicant to make an election even though the Restriction Requirement is traversed, Applicant hereby provisionally and respectfully elects Group II, presently claims 2, 4-13, 17-26, 31 and 55, with traverse and without prejudice. The reasons for traversal are set forth below.

As regards the species election, claims 16 and 35 have not been elected, and therefore Applicant understands that no species election is necessary at this time. If

Applicant misunderstands, then clarification is respectfully requested.¹

Returning to the Restriction Requirement and reasons for traversal, Applicant first notes that there is no lack of unity of invention. In the absence of evidence to the contrary, the single inventive concept is defined by claim 1, and thus PCT rules 13.1 and 13.2 are fulfilled and the Restriction Requirement is improper under PCT Unity of Invention rules. This is confirmed by what occurred during the International Preliminary Examination as noted in the IPER, first page, i.e. PCT/IPEA/409 (cover sheet), part 3, box IV which is **not checked** for lack of unity of invention.

This Restriction Requirement is thus in violation of the Patent Cooperation Treaty to which the United States is a signatory.

Moreover, even under U.S. law, the PTO has no authority to take the position that a single claim, e.g. one of claims 18-26 and 55, which claims are listed as being in all four groups, calls for more than one invention, except in the sense of those claims being generic and subject matter falling there within being species. The PTO has not taken this latter position because the requirement set forth on page

¹ As Applicant understands that no election of species is required at this time, Applicant also understands that there is no need to provide a listing of claims which read on any elected species.

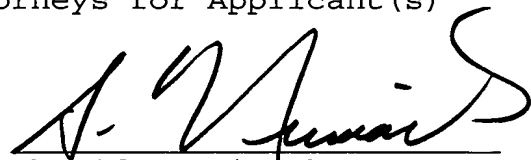
2 of the Office Action is a Restriction Requirement rather than an Election of Species Requirement. With respect, the PTO is **challenged** to provide any legal authority for such a restriction requirement, it being noted that 37 C.F.R. 1.475(d) says nothing about finding plural inventions in a single claim.

Applicant respectfully requests withdrawal of the improper Restriction Requirement and requests examination of all the claims on the merits.

Respectfully submitted,

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